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EXAMINER

MANAHAN, TODD E

ART UNIT

PAPER NUMBER

3732

DATE MAILED: 10/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 18

Application Number: 09/923,113
Filing Date: August 06, 2001
Appellant(s): WOLF, SHANE D.

MAILED
OCT 09 2003
GROUP 3700

Peter Giancana=
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 13 August 2003.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is incorrect.

No amendment after final has been filed. Appellant filed a Request for Reconsideration on 9 May 2003, which did not propose any amendment to the claims.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 14 and 17-24 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

970,406	TINDALL	9-1910
5,000,599	MC CALL et al.	3-1991

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 14, 17-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tindall (U.S. Patent No. 970,406) in view of McCall et al. (U.S. Patent No. 5,000,599).

Tindall discloses a pair of scissors comprising a head region, a handle region comprising finger loops 6,7 and deformable grips 12 located within each loop. Each grip includes a deformable outer surface 13 an inner surface and a chamber therebetween. Each grip further may include a groove 14 that receives a portion of the inner diameter of each loop. Tindall discloses the invention essentially as claimed except for the viscous material. McCall discloses a similar deformable grip having a deformable outer surface 28 that surrounds an inner layer of viscous medium 30 (figure 3) or alternatively an outer layer 34, and inner layer 38 connected by radially oriented webs 36 defining chambers having viscous medium therein and having vents 42 to permit passage of viscous medium between the chambers (figure 7). The viscous medium may be a putty such as vinyl elastomer or silicone-based putty (col. 4, lines 35-37) or a room temperature curable substance (col. 4, lines 52-62). As such, the grip will deform to the anatomical contours of the individual user in a custom fit manner and retain the deformation for a substantial period of time, for example at least five seconds. It would have been obvious to one

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skilled in the art to fill the chambers of the grips of Tindall with a viscous medium as taught by McCall et al in order that the grip will deform to the anatomical contours of the individual user in a custom fit manner and retain the deformation for a substantial period of time, for example at least five seconds.

(11) Response to Argument

Appellant's arguments regarding the prematurity of the Final Rejection are moot. It is noted that this is not an appealable issue. "This is purely a question of practice, wholly distinct from the tenability of the rejection. It may not be advanced as a ground for appeal, or made the basis of complaint before the Board of patent appeals and Interferences. It is reviewable by petition under 37 CFR 1.181." (MPEP 706.07(c)).

Appellant argues that there is no suggestion to combine the Tindall and McCall et al. references, stating "McCall (sic) never taught that his grip may be desirable on shears" (page 5 of Appellant's Brief, line 32). The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, McCall et al. clearly teaches the desirability of a grip having a viscous medium in the chamber with vents between the chamber. In col. 1, lines 52-65, McCall et al set forth some of the problems with such air filled grips, namely grip's tendency to spring back immediately to its undeformed state. By filling the chambers with a viscous medium, McCall et al create a grip that "assumes a custom fit configuration when

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gripped for enhanced user comfort and reduced fatigue” and “retains the custom fit configuration for a substantial period of time” (col. 2, lines 9-13). By retaining such configuration, “the grip can be released and regripped by the same user without undergoing significant shape change” (col. 2, lines 34-38). The appellant further argues that McCall et al. only teach using such a grip for writing instruments, paintbrushes and jeweler’s tools and not shears. A reference is not limited to preferred embodiments, but rather all of the disclosure must be evaluated for what they fairly teach one of ordinary skill in the art (*In re Boe*, 148 USPQ 507 (CCPA 1966)). In the description of the prior art, McCall et al discuss use of resilient grips to achieve enhanced comfort and reduced fatigue during use and that one manner of providing cushioned grip surfaces in the prior art was by utilizing sleeve-like structures having air chambers therein (column 1, lines 45-55). McCall et al. go on to describe problems with such air filled grips, namely the grip’s tendency to spring back immediately to its undeformed state, which McCall et al are trying to overcome (column 1, lines 55-65). By filling the chambers with a viscous medium, McCall et al create a grip that “assumes a custom fit configuration when gripped for enhanced user comfort and reduced fatigue” and “retains the custom fit configuration for a substantial period of time” (col. 2, lines 9-13). By retaining such configuration, “the grip can be released and regripped by the same user without undergoing significant shape change” (col. 2, lines 34-38). Thus, when taken as a whole, McCall et al clearly provide motivation to one skilled in the art to replace the air chambers of Tindall with chambers filled with a viscous medium.

Appellant also argues that Tindall teaches away from the proposed combination because Tindall states that the cushion “may be filled with air at atmospheric pressure, or at any greater

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pressure, as may be desired, thus giving the cushion tubes any desired resistance". This however does mean that Tindall envisions the grips to be non-deformable. Rather, Tindall suggests that the amount of deformability of the cushion, or resistance, of the cushioned grips can be varied depending upon the amount of air pressure therein. McCall et al., however, discuss some of the shortcomings of this approach of filling cushions of a grip with air, namely grip's tendency to spring back immediately to its undeformed state. By filling the chambers with a viscous medium, McCall et al create a grip that "assumes a custom fit configuration when gripped for enhanced user comfort and reduced fatigue" and "retains the custom fit configuration for a substantial period of time" (col. 2, lines 9-13). By retaining such configuration, "the grip can be released and regripped by the same user without undergoing significant shape change" (col. 2, lines 34-38). This would appear to be particularly beneficial to the grips of a scissors which are repeatedly opened and closed, alternatively applying pressure and relaxing pressure on the finger loops, as it would prevent the grips from immediately springing back each time the pressure on the grips is relaxed.

For the above reasons, it is believed that the rejections should be sustained.

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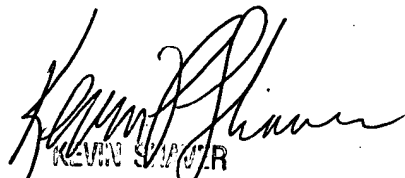
Respectfully submitted,

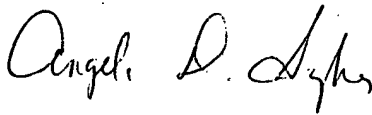
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September 11, 2003

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